

## REMARKS/ARGUMENTS

### **Double Patenting Rejection**

Examiner has rejected claims 1-21, 28 and 43 as provisionally rejected under the judicially created doctrine of obviousness-type double patent over claims 1-7, 9 and 12-14 of copending application No. 10/715,745 to Rathore et al. A terminal disclaimer is filed herewith.

### **Rejections based upon 35 U.S.C. 102(e)**

Examiner has rejected claims 1-21, 28, 40-41 and 43 under 35 U.S.C. 102(e) as anticipated by US2004/0151755 (Rathore, et al.).

Applicants submit herewith a declaration from inventors Osman Rathore and Ann-Margret Andersson, stating that they "are the inventors of any subject matter included in US2004/0151755 relating to polymers comprising antimicrobial metal salts". Accordingly Rathore et al. is not prior art under 35 U.S.C. 102(e). Applicants submit that the rejection based upon 35 U.S.C. 102(e) has been traversed.

### **Rejections based upon 35 U.S.C. 102(b) or 35 U.S.C. 103**

Examiner has rejected claims 1-16, 19-21, 28 and 43 as anticipated under 35 U.S.C. 102(b) or unpatentable under 35 U.S.C. 103 in view of US 4,576,453 ("Borowsky") or EP 1,505,314 ("Barry et al.")

Borowsky discloses "an optically graded contact lens for occluding light for light sensitive lens wearers." Column 1, lines 5-6. The shaded region is formed by precipitating silver chloride in the gel matrix, exposing the silver to light, placing the lens in a commercial developer to yield a reduced silver shade and removing excess silver chloride with a fixer. Column 3, line 66-column 4, line 9. There is nothing in Borowsky which would suggest that the lenses disclosed therein are antimicrobial. In fact, the example of Borowsky was repeated by Dr. Douglas Vanderlaan, and the lenses so made were found not to display statistically significant antimicrobial activity. Claims 1 and 28 have been amended to recite that the lenses of the present invention exhibit

There is absolutely nothing in Borowsky to suggest that the Borowsky lenses would have any property other than photochromicity, or that any process should be used other than the process disclosed therein. The Vanderlaan declaration clearly shows that the Borowsky lenses are not antimicrobial. Accordingly, Examiner has not made a *prima facie* showing that Borowsky would have suggested to one of skill

in the art any antimicrobial lens, let alone the antimicrobial contact lenses recited in the present application.

Applicants have amended claims 1 and 18 to further recite that the lenses of the present invention

Barry et al. discloses contact lenses that contain ceramic carriers, such as zeolites which retain antimicrobial metal ions. Zeolites are specifically excluded from the definition of metal salts in the present invention. See page 3, lines 21-22 of the present specification. Accordingly, Barry et al. does not anticipate the present claim as it lacks a recited element of the claims, an antimicrobial salt. The passages in Barry et al. noted by Examiner, abstract at lines 1-8, column 6, lines 6-8 and column 7, lines 32-44, disclose using silver ions with a *zeolite*. Zeolites are not salts, and as mentioned above, are specifically excluded from the definition of metal salts in the present application. Applicants respectfully submit the 35 U.S.C. 102 rejection based upon Barry et al. has been traversed.

Examiner has also rejected the claims of the present invention as obvious in view of Barry et al. Barry et al. does not disclose or suggest that any material other than a zeolite should be used, and does not suggest that the metal salts disclosed in the present application may be incorporated into a contact lens. The Examiner bears the initial burden of proving a *prima facie* case of obviousness. In this case Barry et al. provides no motivation whatsoever to replace the zeolites which are disclosed therein with the metal salts recited in the claims of the present invention.

Moreover, Barry et al. clearly teaches away from claims 19-21 of the present invention (which require metal salts with recited solubilities). Barry states

*"it is important to design an antimicrobial contact lens that does not release the antimicrobial agent into ophthalmic solution or the eye, to avoid adverse or unwanted reaction."* Barry et al. column 2, lines 46-49.

*"A lens of the invention does not leach the antimicrobial agent into the eye during use"* Barry et al. column 3, line 11-13.

Thus, Barry et al. clearly teaches away from claims 19-21.

Claims 2-16, 19-21, and 43 all depend from claim 1 and are similarly novel and patentable over Barry et al and Borowsky.

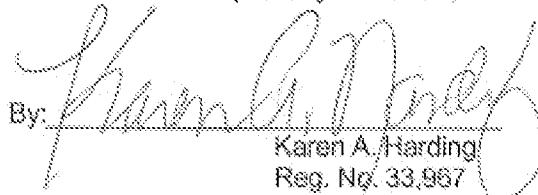
Examiner has further rejected claims 17-18 and 40-41 as unpatentable over Borowsky or Barry, et al. individually in view of Rathore et al. or McCabe, et al.

As described above, neither Borowsky nor Barry et al. disclose or suggest the presently claimed invention. With respect to Rathore et al. Applicants respectfully submit that since Rathore et al. is not prior art under 35 U.S.C. 102(e), it is not available as prior under 35 U.S.C. 103. Accordingly, as neither Borowsky nor Barry et al. disclose or suggest the presently claimed invention, and Rathore, et al. has been removed as a reference under U.S.C. 103, Applicants respectfully submit that the rejections of claims 17-18 and 40-41 over either Borowsky or Barry et al. in view of Rathore et al. have been traversed.

With respect to the rejection based upon either Borowsky or Barry et al. taken in combination with McCabe et al., as discussed above, neither Borowsky nor Barry et al. disclose or suggest antimicrobial lenses comprising metal salts. McCabe et al. has no disclosure or suggestion of incorporating metal salts into a contact lens. Accordingly, none of the references Borowsky, Barry et al. or McCabe et al., taken alone or in combination disclose or suggest antimicrobial lenses comprising metal salts.

Applicants respectfully submit that the foregoing arguments have traversed the Examiner's rejections. Withdrawal of the rejections and allowance of the claims as amended is respectfully requested.

Respectfully submitted,

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